

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-16, 24-29, and 34-40 are currently pending. Claims 17-23 have been cancelled without prejudice or disclaimer; Claims 1, 4, 5, 11, 24, 26, and 34 have been amended; and Claims 36-40 have been added by the present amendment. The changes and additions to the claims are supported by the originally filed specification and do not add new matter.¹

In the outstanding Office Action, Claims 1, 2, 4, 6, 11, 12, 14, 17, 19, 20, 24, 26, 27, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP Patent Application Publication No. 2001-270194 to Kobayashi (hereinafter “the ‘194 application”) in view of U.S. Patent No. 7,164,486 to Nakamura et al. (hereinafter “the ‘486 patent”) and U.S. Patent Application Publication No. 2002/0156704 to Kolls (hereinafter “the ‘704 application”); Claims 3, 5, 7, 16, 18, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘194 application in view of the ‘486 patent, the ‘704 application, and JP Patent Application Publication No. 2001-217972 to Kajita (hereinafter “the ‘972 application”); Claims 9, 22, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘194 application in view of the ‘486 patent, the ‘704 application, and U.S. Patent No. 5,892,595 to Yamakawa et al. (hereinafter “the ‘595 patent”); Claims 8, 15, 21, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘194 application in view of the ‘486 patent, the ‘704 application, and U.S. Patent Application Publication No. 2002/0036643 to Namizuka et al. (hereinafter “the ‘643 application”); Claims 10 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘194 application in view of the ‘486 patent, the ‘704 application, the ‘643 application, and U.S.

¹ See, e.g., Fig. 4 and the discussion related thereto; and page 13, lines 17-25 of the originally filed specification.

Patent Application Publication No. 2001/0019429 to Oteki et al. (hereinafter “the ‘429 application”); and Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘194 application in view of the ‘486 patent, the ‘704 application, and U.S. Patent Application Publication No. 2001/0015821 to Namizuka et al. (hereinafter “the ‘821 application”).

Further, the Advisory Action dated August 28, 2009, maintains the rejections of the outstanding Office Action.

REJECTION UNDER 35 U.S.C. § 103

Amended Claim 1 is directed to an image forming apparatus, comprising:

- an image reading device configured to read an image of an original document;

- an image forming device configured to form an image on a sheet in accordance with image data read by the image reading device;

- an operation unit connecting device configured to detachably connect an operation unit, said operation unit being configured to accept inputting of operational instructions for operating the image forming apparatus and to connect to the image forming apparatus via the operation unit connecting device;

- a process controller configured to control an operation of at least one of the image reading device and the image forming device; and

- an expansion unit connecting device configured to connect an additionally attachable expansion unit, said additionally attachable expansion unit including an expansion control device and being configured to further connect to the operation unit detached from the image forming apparatus, wherein

- said additionally attachable expansion unit connects to the image forming apparatus via the expansion unit connecting device, and

- while the additionally attachable expansion unit is determined to be connected to the expansion unit connecting*

device, the expansion control device controls the at least one of the image reading device and the image forming device.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the '194 application is directed to an image forming apparatus which carries out complex functions which make it possible to connect it to a plurality of external apparatuses. In particular, the Office Action, cites the '194 CPU 102 for teaching the claimed process controller and the '194 external apparatus for teaching the claimed additionally attachable expansion unit.²

However, it is respectfully submitted that the '194 application fails to disclose while the additionally attachable expansion unit is determined to be connected to the expansion unit connecting device, the expansion control device controls the at least one of the image reading device and the image forming device. Rather, the '194 application simply discusses, with respect to the cited CPU 102, that the CPU 102 must **carry out main body control and extended feature operating part control.** Further, the '194 application discusses that a first objective is to provide an image forming apparatus which is equipped with an operating part control part such that the image forming apparatus main body controls the operating part when an external apparatus is not connected and sets in place either an operating part control switching part or an external apparatus **so that the image forming apparatus main body or external apparatus can control the operating part when an external apparatus is connected** so that there is no decline in performance when features are expanded and costs are not increased by the addition of a connector/harness. The '194 application does not disclose that, *while the external apparatus (i.e., the asserted additionally attachable expansion unit) is determined to be connected to the image forming apparatus, an expansion control device included in the external apparatus controls the at least one of an image reading device and an image forming device.*

² See Office Action dated May 13, 2009, pages 6 and 7.

Further, it is respectfully submitted that the '486 patent and the '704 application fail to remedy the deficiencies of the '194 application, as discussed above. The '486 patent is directed to an image forming apparatus, expansion box for image forming apparatus, and image editing system.

However, it is respectfully submitted that the '486 patent fails to disclose while the additionally attachable expansion unit is determined to be connected to the expansion unit connecting device, the expansion control device controls the at least one of the image reading device and the image forming device. Rather, the '486 patent discusses that two copying manipulations are offered on the image editing system 100. One is the copying instruction through the operation panel 15 mounted on the image forming apparatus 10 and the other is the copying instruction performed with the use of the large screen display 71 of the expansion box 50 side.³ That is, the '486 patent discusses that both the image forming apparatus 10 and the expansion box 50 have control over copying operations. The '486 patent does not disclose that *while the expansion box (i.e., the asserted additionally attachable expansion unit) is determined to be connected to the image forming apparatus*, an expansion control device included in the expansion box *controls at least one of an image reading device and an image forming device.*

Further, the '704 application is directed to a method of constructing a digital content play list for transmission and presentation on a public access electric terminal. However, it is respectfully submitted that the '704 application fails to disclose while the additionally attachable expansion unit is determined to be connected to the expansion unit connecting device, the expansion control device controls the at least one of the image reading device and the image forming device. Moreover, the Office Action does not cite the '704 application for teaching the expansion control device.

³ See '486 patent, column 20, lines 34-39.

Thus, no matter how the teachings of the '194 application, the '486 patent, and the '704 application are combined, the combination does not teach or suggest the expansion control device of Claim 1. That is, a general controller is changed in accordance with the usage of the additionally attachable expansion unit. Accordingly, it is respectfully submitted that independent Claim 1 (and all associated dependent claims) patentably defines over any proper combination of the '194 application, the '486 patent, and the '704 application.

Amended Claim 11 recites limitations analogous to the limitations recited in Claim 1. Further, Claim 11 has been amended in a manner analogous to the amendments to Claim 1. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 1, it is respectfully submitted that independent Claim 11 (and all associated dependent claims) patentably defines over any proper combination of the '194 application, the '486 patent, and the '704 application.

Amended Claim 24 recites, *inter alia*,

while the additionally attachable expansion unit is determined to be connected to the expansion unit connecting device, controlling by the expansion control device the at least one of the image reading device and the image forming device.

As noted above, the '194 application, the '486 patent, and the '704 application, alone or in proper combination, fail to disclose the expansion control device recited in Claim 1. Thus, the '194 application, the '486 patent, and the '704 application fail to disclose the method of independent Claim 24. Accordingly, it is respectfully submitted that independent Claim 24 (and all associated dependent claims) patentably defines over any proper combination of the '194 application, the '486 patent, and the '704 application.

Further, it is respectfully submitted that the rejections of Claims 17-23 have been rendered moot by the present cancellation of those claims.

Regarding the rejections of dependent Claims 3, 5, 7, 16, and 25 under 35 U.S.C. § 103(a), it is respectfully submitted that the '972 application fails to remedy the deficiencies of

the '194 application, the '486 patent, and the '704 application, as discussed above.

Accordingly, it is respectfully submitted that dependent Claims 3, 5, 7, 16, and 25 patentably define over any proper combination of the '194 application, the '486 patent, the '704 application, and the '972 application.

Regarding the rejections of dependent Claims 9 and 29 under 35 U.S.C. § 103(a), it is respectfully submitted that the '595 patent fails to remedy the deficiencies of the '194 application, the '486 patent, and the '704 application, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 9 and 29 patentably define over any proper combination of the '194 application, the '486 patent, the '704 application, and the '595 patent.

Regarding the rejections of dependent Claims 8, 15, and 28 under 35 U.S.C. § 103(a), it is respectfully submitted that the '643 application fails to remedy the deficiencies of the '194 application, the '486 patent, and the '704 application, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 18, 15, and 28 patentably define over any proper combination of the '194 application, the '486 patent, the '704 application, and the '643 application.

Regarding the rejection of dependent Claim 10 under 35 U.S.C. § 103(a), it is respectfully submitted that the '429 application fails to remedy the deficiencies of the '194 application, the '486 patent, the '704 application, and the '643 application, as discussed above. Accordingly, it is respectfully submitted that dependent Claim 10 patentably defines over any proper combination of the '194 application, the '486 patent, the '704 application, the '643 application, and the '429 application.

Regarding the rejection of dependent Claim 13 under 35 U.S.C. § 103(a), it is respectfully submitted that the '821 application fails to remedy the deficiencies of the '194 application, the '486 patent, and the '704 application, as discussed above. Accordingly, it is

respectfully submitted that dependent Claim 13 patentably defines over any proper combination of the '194 application, the '486 patent, the '704 application, and the '821 application.

CONCLUSION

The present amendment also sets forth new Claims 36-40 for examination on the merits. No new matter has been added. New Claims 36-38 recite features analogous to the features previously recited in independent Claims 1, 11, and 24, respectively. Further, new Claim 39 recites, *inter alia*,

while the expansion unit is determined to be connected to the image forming apparatus, the expansion control device controls the at least one of the image reading device and the image forming device.

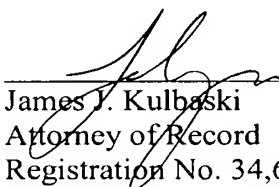
As noted above, the applied references, alone or in proper combination, fail to disclose the expansion control device recited in Claim 1. Thus, the applied references fail to disclose the expansion control device of independent Claim 39. Accordingly, it is respectfully submitted that independent Claim 39 (and dependent Claim 40) patentably defines over any proper combination of the applied references.

Thus, it is respectfully submitted that independent Claims 1, 11, 24, and 39 (and all associated dependent claims) patentably define over any proper combination of the '194 application, the '486 patent, the '704 application, the '972 patent, the '595 patent, the '643 application, the '429 application, and the '821 application.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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